Rejection of Claims of Art Grounds in the 11 November 2004 Office Action, and

Traversal Thereof

In the 11 November 2004 Office Action, claims 1, 3-5, 7-10 and 12-21 were rejected

under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., "Managing the software

design documents with XML", Proceedings of the 16th annual international conference on

Computer documentation, September 1998 (hereafter Suzuki) in view of Chao et al., US

Patent No. 6,711,299 (hereinafter Chao). The above rejections of the claims 1, 3-5, 7-10 and

12-21 are traversed, and consideration of the patentability of claims 1, 3-5, 7-10 and 12-21, as

amended, is requested in light of the ensuing remarks.

The Present Invention Is Not Obvious Over The Cited References

A claimed invention may be found to have been obvious "if the differences between

the subject matter sought to be patented and the prior art are such that the subject matter as a

whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Moreover,

the Federal Circuit has ruled on numerous occasions that a holding of "obviousness" requires

some motivation, suggestion or teaching within the cited references that would lead one

skilled in the art to modify the cited reference or references as claimed by applicant. See, for

example, In re Kotzab, 217 F3d 1365, 55 USPQ2d 1313 (Fed Cir. 2000):

> "Most if not all inventions arise from a combination of old elements. See In re
> Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every
> element of a claimed invention may often be found in the prior art. However,
> identification in the prior art of each individual part claimed is insufficient to defeat

patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited Suzuki reference and the cited Chao patent describe software tools. The claims of the present application also describe a software tool. The invention described by Suzuki pertains to the management of software design tools using XML. On the other hand, the Chao patent discloses a software tool for compressing image files using a wavelet-based transformation. The present invention also discloses a software tool. However, the software tool of the present invention as specifically claimed is novel and non-obvious over the cited references.

The present invention relates to a method and system for developing software. More particularly, the invention relates to a method and system for generating software documentation having navigation links between diagram portions and textual portions of the software documentation. Source code can be written in any number of software languages. As a consequence, the ability to identify the software language in which a source code is written while generating software documentation is advantageous. The present invention has the ability to <u>identify the language of the source code, obtain a template for the language and parse the source code</u> in order to generate software documentation having navigation links between diagram portions and textual portions of the software documentation. The claims of the present application have been amended to clarify that the present invention is a method and system for generating software documentation from a source code written in any one of a

variety of software languages. Neither Suzuki, Chao nor any of the other cited references have a need to identify the language of the source code, obtain a template for the language and parse the source code in order to generate software documentation having navigation links between diagram portions and textual portions of the software documentation. Moreover, there is no suggestion or teaching within either Suzuki or Chao that would lead one skilled in the art to modify the cited references to include steps of identifying the language of the source code, obtaining a template for the language and parsing the source code.

Support for the added limitations can be found as original in the present specification in paragraphs [0077] and [0092] as well as in FIG. 11. Therefore, no new matter has been added by this amendment.

CONCLUSION

In view of the foregoing amendments and for the above reasons, it is believed that this application is now in condition for allowance. If unresolved issues remain, the Examiner is invited to telephone applicant's attorney at the number below.

Respectfully submitted,

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